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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,801	05/31/2005	Wolfgang Edcler	915-006.063	4510

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EXAMINER

CHEN, JUNPENG

ART UNIT PAPER NUMBER

2631

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,801

Applicant(s)

EDELER, WOLFGANG

Examiner

Junpeng Chen

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/02/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement submitted on December 02, 2004 have been considered by the Examiner and made of record in the application file.

Preliminary Amendment

2. The present Office Action is based upon the original patent application filed on December 02, 2004 as amended by the preliminary amendment filed on December 02, 2004 to amends claims 1-20, specification and add an abstract. **Claims 1 - 20** are now pending in the present application.

Objection - Drawing

3. The drawings are objected to because some figures have blocks that lack descriptive labels. For example, block 8 in figure 1 should be additionally labeled as: "Mixer". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of **claims 1 and 11** recites a negative limitation "without influencing the recorded audio signal" where the specification does not have a basis to support of. Even though the specification mentions "...recording from an audio source during active phone calls without disturbing the recording..." as in lines 7-9 of page 2 of current application, applicant is reminded that "*recorded*" audio signal is not the same as the "*recording*" of an audio. See MPEP § 2173.05(i).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2-3, 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and 2 are rejected under 35 U.S.C. 112, second paragraph for failing to clearly define recited "a audio monitor audio signal" as in claim 1 and clearly differentiate between "a audio monitor audio signal" as in claim 1 and the "signal indicative of the recording state" as in claim 2. For the purpose of further examination, "a audio monitor audio signal" will be treated as the signal from the radio receiver.

Claim 2 is depending on claim 2 itself, this makes claim 2 become indefinite because a claim cannot depend on itself. For the purpose of further examination, the examiner will examine claim 2 as it is depending on claim 1.

Claim 3 is depending on claim 3 itself, this makes claim 3 become indefinite because a claim cannot depend on itself. For the purpose of further examination, the examiner will examine claim 3 as it is depending on claim 2.

Claim 10 and 13 are rejected under 35 U.S.C. 112, second paragraph for failing to clearly define recited "a audio monitor audio signal" as in claim 10 and clearly differentiate between "a audio monitor audio signal" as in claim 10 and the "signal indicative of the proceeding recording operation" as in claim 13. For the purpose of further examination, "a audio monitor audio signal" will be treated as the signal from the radio receiver.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 18 recites "program code means" for carrying out steps where the specification fails to specifically mention examples of "program code means". A person of ordinary skill in the art would interpret recited "program code means" as radio frequency or light wave transmissions, which do not fall under statutory subject matter.

Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each claim 19 and 20 recites "a computer readable medium" for carrying out a method where the specification fails to specifically mention examples of "a computer readable medium". A person of ordinary skill in the art would interpret recited "a computer readable medium" as radio frequency or light wave transmissions, which do not fall under statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kanamori et al. (U.S. Patent 6,662,022 B1)** in view of **Logan et al. (U.S. Patent 7,058,376 B2)**.

Consider **claim 1**, Kanamori et al. discloses a mobile electronic device (*read as a portable telephone set, Figure 1, abstract*) having a first audio component for providing a first audio signal (*read as music replay means provides music, abstract*) and a second audio component for providing a second audio signal (*taking means provides taking voices, abstract*), and an audio output for outputting an audio signal), said audio output being connected to said first and second audio components, and a mixer, connected between said first and second audio component and said audio output for mixing said first audio signal and said second audio signal to generate a mixed signal to be supplied to said audio output (*read as the talking voice and replayed music are mixed using mixer 206 in the voice output control part 113 and supplied to headphone terminal 112, Figure 1 and Figure 2, lines 9-21 of column 5 and line 35-42 of column 5*).

However, Kanamori et al. fails to disclose that [the] first audio component provides continuous audio signal and comprises a radio receiver and an audio recorder

configured for receiving radio programs and recording from said radio receiver and providing a audio monitor audio signal as said first continuous audio signal, without influencing the recorded audio signal from the radio receiver.

In related art, Logan et al. discloses a radio receiving, recording and playback system which comprises a recorder 109, would display recording status with LCD display 115 in Figure 1, lines 12-17 of column 20. As a person with ordinary skill in the art would understand, this radio system would provide a radio signal (read as would be the first continuous audio signal) and as long as the recording would not overwrite the existing data, recording would not influences the existing data (read as recorded audio/music) in the memory.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate the teachings of Logan et al. into the teachings of Kanamori et al., which modified by Logan et al, and replace the music replay mean with the radio receiving, recording and playback system for the purpose of allowing the users to use a cell phone and receive radio programs and record the music they like from the receiving radio. Also, the combining a radio receiver and a cell phone into one device is suggested by Joseph Saro (WO 9828896), lines 13-18 of page 2.

Consider **claim 2, as applied to claim 1 above (See *Claim Rejections - 35 USC § 112* above)**, Kanamori et al., as modified Logan et al., discloses the claimed invention except the audio recorder comprises a component generating a signal indicative of the recording state of [the] audio recorder.

However, Logan et al. further discloses that the recording status would be displayed with LCD display 115 in Figure 1, lines 12-17 of column 20. Therefore, the recorder 109 in Figure 1 would inherently generate a signal for indicating the recording status.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to further incorporate the teachings of Logan et al. into the teachings of Kanamori et al., which modified Logan et al., for the purpose of allowing the users to know the recording status.

Consider **claim 3, as applied to claim 2 above (See *Claim Rejections - 35 USC § 112* above)**, Kanamori et al., as modified Logan et al., discloses that [the] mixer comprises a component to receive a signal indicative (*Interpreted as after modification Logan et al. above, the voice output control part 113 is connected following the radio receiver/recorder 109, the voice output control part 113 must comprises a component to receive the indicating signal as claimed in claim 2*) and a component for adjusting the ratio of amplitudes in accordance with [the] received signal (*Interpreted as after modification Logan et al. above, the volume of the received signal is settable by user, lines 40-52 of column 3 by Kanamori et al.*), but fails to discloses that the signal indicative is for whether one of said audio signals of said audio components is actually recorded or not.

However, Logan et al. further discloses that for recording, full time bar would represent the length of the entire show and the moving marker would shown where in the program the listener was at that time, lines 18-29 of column 20. Specifically, if the

moving marker is at the end of the bar, which would mean the audio is recorded, if not, the recording is not done.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made would incorporate the teachings by Logan et al. into the teachings by Kanamori et al., which modified Logan et al., for the purpose of allowing the users to know the status of recording.

Consider **claim 4, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses at least one of [the] audio components comprises an input terminal for an external audio signal (*read as talking means comprises microphone 103 for receiving talking voice, Figure 1, lines 3-9 of column 5*).

Consider **claim 5, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses a component for determining the amplitudes of [the] first audio signal and [second] audio signal (*read as the volume of each audio will come out from the microphone 103, the user will know the volume level, such as high or low using the microphone 103, lines 3-9 of column 1*).

Consider **claim 6, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses that the mixer further comprises means for adjusting the ratio of amplitudes of [the] first and second audio signal in [the] mixed signal (*read as the voice output control part 113 comprises Talking volume 203 and Music Volume Adjusting Part 205 to adjust the volume of the audios, Figure 2, line 27-42 of column 5*).

Consider **claim 7, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses that [the] audio components comprises and audio player

(Interpreted as after the modification Logan et al. above, the first audio component is a radio receive that is capable of receiving music stations and playing the music).

Consider **claim 8, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses that [the] audio components comprises a mobile phone *(read as first audio component a talking mean (portable telephone), abstract).*

Consider **claim 9, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses one of [the] audio components comprises a component for encoding/decoding audio signals *(read as when making telephone communication, the main control part 111 encodes the digitized voice data by a prescribed voice compression coding system and the main control part 111 decodes the received voice information to voice data on the basis of the prescribed voice compression coding system, Figure 1, lines 55-65 of column 5 and lines 2-6 of column 6).*

Consider **claim 10, as applied to claim 1 above**, Kanamori et al., as modified Logan et al., further discloses that [the] audio output comprises an audio connector for connecting headphones *(read as the headphone 112 is connected to the voice output control part 113, Figure 1, lines 60-65 of column 4).*

Consider **claim 11**, Kanamori discloses a devices *(read as a portable telephone set, Figure 1, abstract)*, and a method of mixing first and second audio signal comprising steps of:

- receiving a second audio signal *(taking means provides taking voices, abstract);*

- mixing second signal and another audio signal (*read as music replay means provides music, abstract*) according to a predetermined ratio of amplitudes, without influencing the recorded audio signal from the radio receiver (*read as the talking voice and replayed music are mixed using mixer 206 in the voice output control part 113 and this voice control part 113 is capable of setting the volume of the audios with Talking volume adjusting part 203 and Music volume adjusting part, and as a person with ordinary skill in the art would know, as long as the recording would not overwrite the existing data, recording would not influences the existing data (read as recorded audio/music) in the memory, Figure 1 and Figure 2, lines 9-21 of column 5 and line 35-42 of column 5*); and
- providing said mixed signal for output (*supplied the mixed audio to the headphone terminal 112, Figure 1 and Figure 2, lines 9-21 of column 5 and line 35-42 of column 5*);

However, Kanamori fails to disclose that the device comprising a radio receiver, and a recorder and the method comprising the steps of:

- receiving a radio program via said radio receiver,
- recording said radio program at said recorder,
- providing a recorder monitor signal of said radio program as a first continuous audio signal;

In related art, Logan et al. discloses a radio receiving, recording and playback system which comprises a recorder 109, would display recording status with LCD

display 115 in Figure 1, lines 12-17 of column 20. As a person with ordinary skill in the art would understand, this radio system would provide a radio signal (read as would be the first continuous audio signal).

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate the teachings of Logan et al. into the teachings of Kanamori et al., which modified by Logan et al, and replace the music replay mean with the radio receiving, recording and playback system for the purpose of allowing the users to use a cell phone and receive radio programs and record the music they like from the receiving radio. Also, the combining a radio receiver and a cell phone into one device is suggested by Joseph Saro (WO 9828896), lines 13-18 of page 2.

Consider **claim 12, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., discloses the claimed invention except the method comprising generating a signal indicative of a proceeding recording operation.

However, Logan et al. further discloses that the recording status would be displayed with LCD display 115 in Figure 1, lines 12-17 of column 20. Therefore, the recorder 109 in Figure 1 would inherently generate a signal for indicating the recording status.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to further incorporate the teachings of Logan et al. into the teachings of Kanamori et al., which modified Logan et al., for the purpose of allowing the users to know the recording status.

Consider **claim 13, as applied to claim 12 above**, Kanamori et al., as modified by Logan et al., discloses the claimed invention except the method comprising detecting a signal indicative of a proceeding recording operation, and mixing [the first] and second signals in accordance with [the] detected signal indicative of a proceeding recording operation (*Interpreted as after modification Logan et al. above, the voice output control part 113 is connected following the radio receiver/recorder 109, the voice output control part 113 must comprises a component to receive the signal indicative as claimed in claim 11, and the mixer 206 inside of voice output control part 113 would mix the two audio signals if both of them are being inputted into the mixer 206*).

Consider **claim 14, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses the method comprising detecting a first and a second audio signal, prior to said step of mixing (*Applicant is reminded that in order to mix two signals, these two signals must be existed and they must be detected and received before the mixing. Therefore, the invention by Kanamori et al, which modified by Logan et al. inherently, does what is claimed*).

Consider **claim 15, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses the method comprising determining the amplitudes of [the] first and second audio signal (*read as the volume of each audio will come out from the microphone 103, the user will know the volume level, such as high or low using the microphone 103, lines 3-9 of column 1*).

Consider **claim 16 and claim 17, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses the method comprising decoding at

least one of [the] first or second audio signals as in claim 16 and encoding at least one of [the] first or second audio signals as in claim 17 *(read as when making telephone communication, the main control part 111 encodes the digitized voice data by a prescribed voice compression coding system and the main control part 111 decodes the received voice information to voice data on the basis of the prescribed voice compression coding system, Figure 1, lines 55-65 of column 5 and lines 2-6 of column 6).*

Consider **claim 18, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses a program comprising carrying out the steps of claim 11 when [the] program is run on a computer or an electronic device (read as the main control part 11 in portable telephone set 100 in Figure 1 would inherently carry out the steps above).

Consider **claim 19, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses a program comprising carrying out the method of claim 11 when [the] program is run on a computer or an electronic device (read as the main control part 11 in portable telephone set 100 in Figure 1 would inherently carry out the steps above).

Consider **claim 20, as applied to claim 11 above**, Kanamori et al., as modified by Logan et al., further discloses a program comprising carrying out the method for mixing audio signals in a mobile electronic device of claim 11 when it is run on a computer or an electronic device (read as the main control part 11 in portable telephone set 100 in Figure 1 would inherently carry out the steps above).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kirmuss, Charles	US 20030081934 A1	Mobile video recorder control and interface
Bruno		
SARO, JOSEPH	WO 9828896 A1	AUDIO INTEGRATOR MODULE

10. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Junpeng Chen whose telephone number is (571) 270-1112. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Junpeng Chen
J.C./jc
September 13, 2006


RAFAEL PEREZ-GUTIERREZ
SUPERVISORY PATENT EXAMINER

9/13/06